

JP



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,171	03/01/2004	Hans Boeni	DT-6766	1015

7590 03/23/2005  
**SIDLEY AUSTIN BROWN & WOOD LLP**  
 787 Seventh Avenue  
 New York, NY 10019

EXAMINER

LOPEZ, MICHELLE

ART UNIT PAPER NUMBER

3721

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

59

<b>Office Action Summary</b>	Application No. 10/790,171	Applicant(s) BOENI ET AL.	
	Examiner Michelle Lopez	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) ☐ All    b) ☐ Some \*    c) ☐ None of:
    - 1. ☒ Certified copies of the priority documents have been received.
    - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 8/3/04.
- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, and 5 rejected under 35 U.S.C. 102(b) as being anticipated by Yeghiazarians (5,914,882).

Yeghiazarians discloses a control process for an at least partially axially hammering and rotating electric hand-held machine tool wherein an electromagnetic clutch 5 arranged in the flow of force between an electric motor 7 and a tool receptacle is controllably connected to computing means 3 connected to at least one sensor 1, wherein the clutch 5 is repeatedly alternately opened and closed in at least one process step controlled by the computing means 3.

With respect to claim 2, Yeghiazarians discloses wherein the clutch 5 is alternately opened and closed at a frequency of 100Hz in the process as shown by Yeghiazarians' prior art col. 2; 56-62.

With respect to claim 3, Yeghiazarians discloses wherein the process step is initiated in the event of an impending tool blockage detected by the computing means via the sensor as shown in the Abstract, with respect to a rotation of a housing as shown in col. 5; 61-64.

With respect to claim 5, Yeghiazarians discloses an electric hand-held machine tool with an at least partially axially hammering and rotating driving means of a tool receptacle wherein an electromagnetic clutch 5 that is controllably connected to computing means 3 connected to at least one sensor 1 is arranged in the flow of force between an electric motor 7 and a tool receptacle, wherein the electromagnetic clutch is controllable by computing means using a control process wherein the clutch is repeatedly alternately opened and closed in at least one process step controlled by the computing means.

3. Claims 1,3, and 5 rejected under 35 U.S.C. 102(b) as being anticipated by Meixner et al. (6,415,875).

Meixner et al. discloses a control process for an at least partially axially hammering and rotating electric hand-held machine tool wherein an electromagnetic clutch 30,31 arranged in the flow of force between an electric motor 11 and a tool receptacle 26 is controllably connected to computing means 48 connected to at least one sensor 46, wherein the clutch 30 is repeatedly alternately opened and closed in at least one process step controlled by the computing means 48.

With respect to claim 3, Meixner et al. discloses wherein the process step is initiated in the event of an impending tool blockage detected by the computing means via the sensor as shown in col. 2;48-52, with respect to a rotation of a housing as shown in col. 1; 8-10.

With respect to claim 5, Meixner et al. discloses an electric hand-held machine tool with an at least partially axially hammering and rotating driving means of a tool receptacle wherein an electromagnetic clutch 30,31 that is controllably connected to computing means 48 connected to at least one sensor 46 is arranged in the flow of force between an electric motor 11 and a tool receptacle 26, wherein the electromagnetic clutch is controllable by computing means 48 using a

Art Unit: 3721

control process wherein the clutch 30 is repeatedly alternately opened and closed in at least one process step controlled by the computing means.

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1,3, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Koslowski (6,863,165).

Koslowski discloses a control process for an at least partially axially hammering and rotating electric hand-held machine tool wherein an electromagnetic clutch 5 arranged in the flow of force between an electric motor 1 and a tool receptacle 3 is controllably connected to computing means 6 connected to at least one sensor 8, wherein the clutch 5 is repeatedly alternately opened and closed in at least one process step controlled by the computing means 6.

With respect to claim 3, Koslowski discloses wherein the process step is initiated in the event of an impending tool blockage detected as an overload of the drive train by the computing means 6 via the sensor 8, with respect to slippage of the clutch as shown in the Abstract.

With respect to claim 5, Koslowski discloses an electric hand-held machine tool with an at least partially axially hammering and rotating driving means of a tool receptacle wherein an electromagnetic clutch 5 that is controllably connected to computing means 6 connected to at least one sensor 8 is arranged in the flow of force between an electric motor 1 and a tool receptacle 3, wherein the electromagnetic clutch 5 is controllable by computing means 6 using a control process wherein the clutch 5 is repeatedly alternately opened and closed in at least one process step controlled by the computing means 6.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Yeghiazarians (5,914,882) in view of Peisert et al. (5,868,208).

Yeghiazarians discloses the invention substantially as claimed, but does not disclose a process step initiated manually by a switch that is connected to the computing means and that can be actuated manually.

However, Peisert teaches a step initiated manually by a switch 92 connected to a computing means via a shut off device 96 and that can be actuated manually for the purpose of reversing the rotation direction of a clutch 76 shutting off the drive mechanism when a presettable torque is reached. In view of Peisert, it would have been obvious to one having ordinary skill in the art to have provide a process step initiated manually by a switch 92

Art Unit: 3721

connected to a computing means via a shut off device 96 and that can be actuated manually in order to reverse the rotation direction of a clutch 76 to shut off the drive mechanism when a presettable torque is reached.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meixner et al. (6,415,875).

Meixner et al. discloses the invention substantially as claimed except that the clutch is alternately opened and closed at a frequency between 20Hz and 100Hz in the process step.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to alternately opening and closing the clutch at a frequency between 20Hz and 100Hz in the process step, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meixner et al. (6,415,875) in view of Peisert et al. (5,868,208).

Meixner discloses the invention substantially as claimed, but does not disclose a process step initiated manually by a switch that is connected to the computing means and that can be actuated manually.

However, Peisert teaches a step initiated manually by a switch 92 connected to a computing means via a shut off device 96 and that can be actuated manually for the purpose of reversing the rotation direction of a clutch 76 shutting off the drive mechanism when a presettable torque is reached. In view of Peisert, it would have been obvious to one having ordinary skill in the art to have provide a process step initiated manually by a switch 92

Art Unit: 3721

connected to a computing means via a shut off device 96 and that can be actuated manually in order to reverse the rotation direction of a clutch 76 to shut off the drive mechanism when a presettable torque is reached.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koslowski (6,863,165).

Koslowski discloses the invention substantially as claimed except that the clutch is alternately opened and closed at a frequency between 20Hz and 100Hz in the process step.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to alternately opening and closing the clutch at a frequency between 20Hz and 100Hz in the process step, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koslowski (6,863,165) in view of Peisert et al. (5,868,208).

Koslowski discloses the invention substantially as claimed, but does not disclose a process step initiated manually by a switch that is connected to the computing means and that can be actuated manually.

However, Peisert teaches a step initiated manually by a switch 92 connected to a computing means via a shut off device 96 and that can be actuated manually for the purpose of reversing the rotation direction of a clutch 76 shutting off the drive mechanism when a presettable torque is reached. In view of Peisert, it would have been obvious to one having ordinary skill in the art to have provide a process step initiated manually by a switch 92



Art Unit: 3721

connected to a computing means via a shut off device 96 and that can be actuated manually in order to reverse the rotation direction of a clutch 76 to shut off the drive mechanism when a presettable torque is reached.

***Conclusion***


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hettich'124, Thome'707, Noser'918, Schaer'515, Bongers-Ambrosius'814, and Meixner'327 are cited to show related inventions.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700